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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,337	01/20/2000	Evgeniy M. Getsin	IACTP010	4283

22242 7590 05/29/2003

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EXAMINER
AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
2143	12

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PPG

Office Action Summary	Application No. 09/488,337	Applicant(s) GETSIN ET AL.	
	Examiner Joseph E. Avellino	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-18 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on May 14, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (hereinafter Roberts) (USPN 6,161,132) in view of Hazenfield (USPN 5,991,374).

5. Referring to claims 1, 7, and 13, Roberts discloses a method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer (server) are adapted to be connected to a network (Internet) (col. 7, line 30 to col. 8, line 2);

storing information on the host computer for allowing the simultaneous playback of the event from the memory on each of the client apparatuses (col. 7, line 30 to col. 8, line 2);

Roberts does not disclose allowing the information to be downloaded utilizing the network for playback after the simultaneous playback. Hazenfield discloses allowing the information to be downloaded utilizing the network for playback after the simultaneous playback (col. 11, lines 5-25, 60-65). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hazenfield with Roberts to allow messages to be stored and played at a later time.

6. Referring to claims 2, 8, and 14, Roberts discloses the event includes a video and audio presentation (col. 2, lines 5-26).

7. Referring to claims 3, 9, and 15, Roberts discloses a method for storing synchronization information as stated above. Roberts does not disclose the information includes a history and data associated with the simultaneous playback. Hazenfield discloses the information includes a history and data associated with the simultaneous playback (col. 11, lines 5-25, 60-65). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hazenfield with Roberts to allow a logging procedure to occur, showing the events that have transpired during the transmission.

8. Referring to claims 4, 10, and 16, Roberts discloses the network is a wide area network (col. 1, lines 57-61). The Office takes the Internet to be synonymous with a wide area network.

9. Referring to claims 5, 11, and 17, Roberts discloses the memory includes a digital video disc (DVD) (col. 2, lines 5-18).

10. Referring to claims 6, 12, and 18, Roberts discloses the information includes chapter information associated with the DVD (col. 4, lines 1-20). The term "track" can

be considered equivalent to a chapter on a DVD since DVD movies are segmented into chapters such as audio CD's are segmented into audio tracks.

Response to Amendment

11. Applicant's arguments filed May 21, 2003 have been fully considered but they are not persuasive.

12. In the remarks, Applicant argues in substance that, (1) Hazenfield does not disclose simultaneous playback, and (2) a *prima facie* case of obviousness has not been constructed due to no suggestion to combine the references of Roberts et al. and Hazenfield.

13. As to point (1), Hazenfield discloses that the server can transmit a command to play the messages on the playlist to the intended remote sites (col. 5, lines 5-15). This is interpreted to mean simultaneously played since all the remote sites receive the control signals at approximately the same instant from the radiopaging company (col. 5, lines 40-50). In this sense the hazenfield reference teaches simultaneous playback.

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hazenfield with Roberts to allow messages to be stored and played at a later time. Roberts does, in fact, teach a "chat room" setting (col. 7, line 30 to col. 8, line 2) which inherently stores messages in a text format. Hazenfield would be an enhancement of that feature by adding a history feature of the simultaneous playback function.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (703) 305-7855. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JEA
May 27, 2003

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100